

### REMARKS

The applicants have carefully considered the Office action dated January 31, 2006. In view of the following remarks, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

The Office action objected to claims 1-23 because the claims allegedly failed to provide a result in the event that the access control list does not include an entry corresponding to the instruction. In the Office action, the examiner indicated the claims would be allowable if the claims were amended to comply with the objections.

Claim 1 recites, *inter alia*, receiving a request to execute an instruction, determining an identity of the instruction, and selectively allowing the execution of the instruction if the access control list includes an entry corresponding to the instruction. The Office action objected to the claims because they failed to provide a result if a condition is not found. However, an objection is proper as to the form of the claim. *MPEP* § 706.01. For example, the examiner could object to the clarity of a claim or formal matters such as a spelling mistake. However, in the instant case, the examiner has asked the applicants to add limitations to the claims. By asking for the applicants to amend the application to include additional limitations, the Office action goes to the merits of the claim and not the form of the claim. Accordingly, the applicants respectfully submit that the objections to claims 1-23 are improper and should be withdrawn.

Presumably, the Office action intended to reject claims as being indefinite under 35 U.S.C. § 112. However, even if such a rejection were made, the rejection would not stand. For claims to be definite under 35 U.S.C. § 112, "the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the

patent grant.” *MPEP* § 2171. Thus, claims must be definite to a person having ordinary skill in the art. In the event that the examiner finds a claim indefinite, the examiner should explain the rejection as either based on indefiniteness or the failure to claim the invention. *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. App. 1984).

The applicants respectfully submit that the claims are definite under 35 U.S.C. § 112. The failure to provide a result or decision path for every possible condition does not make a claim indefinite. Patents routinely issue that fail to specify alternate conditions. For example, “perform function A based on condition 1” provides no alternative to function A when condition 1 is not satisfied. Certainly this claim would not be rejected merely because the applicant failed to provide a result when condition 1 is not satisfied. The pending claims are no different in this respect.

Additionally, the claims are the metes and bounds of what the applicants considers his or her invention. Under 35 U.S.C. § 112, the claims are “to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability[.]” *MPEP* § 2173. The failure to provide a result to satisfy a condition provides no lines of demarcation as to clarify what the claim is or is not. Stated differently, the applicants are not required to recite every single result or every single outcome in the claim. By requiring the applicants submit the alternate result, the examiner is asking the applicants to claim the results that are not necessarily a part of the claimed invention.

Accordingly, the applicants respectfully submit the claims are definite under 35 U.S.C. § 112 and all pending claims are in condition for allowance.

**Examiner Interview Summary**

Applicants' representative, Simon Booth, conducted various telephone conferences with the examiner over May 30, 2007. In these telephone conferences, the examiner indicated that potentially new art has come to light with regard to the pending claims. While the examiner did not identify the art in particular, the undersigned respectfully requests the examiner to consider the potentially new art and to issue a form PTO-892 listing the same. Of course, any Office action based on the potentially new art should be non-final in nature.

If the examiner is of the opinion that further telephonic communication will expedite the prosecution of this case, the examiner is asked to telephone the undersigned.

Respectfully submitted,

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/Mark C. Zimmerman/

Mark C. Zimmerman  
Reg. No. 44,006  
Hanley, Flight, & Zimmerman L.L.C.  
150 S. Wacker Drive  
Suite 2100  
Chicago, Illinois 60606  
312.580.1020  
**Attorneys for Intel Corporation**